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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,724	02/29/2000	Geoffrey H. Gill	03188-P0001A	1108

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ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619	TINKLER, MURIEL S

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/515,724	GILL ET AL.
	Examiner	Art Unit	
	Muriel Tinkler	3691	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 November 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All   b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

This application has been reviewed. Claims 1-19 are pending. The Examiner's response and rejection(s) are as stated below.

Response to Arguments

1.   Applicant's arguments filed November 5, 2007 have been fully considered but they are not persuasive. The Applicant argues that Kravitz (US 6,029,150 A) does not disclose the use of an untraceable money code. The Examiner disagrees. Not only does Kravitz (US 6,029,150 A) teach the use of a money code, but also discloses it as prior art in the Background Section. Specifically, Kravitz (US 6,029,150 A) discloses an anonymous transaction of digital goods between a merchant and a customer in column 24 (line 66) through column 25 (line 3). Kravitz (US 6,029,150 A) also discloses the use of electronically emulating cash as prior art in the Background Section, specifically in column 2 (lines 23-31). Furthermore, Kravitz (US 6,029,150 A) discloses the use of electronic coins as prior art in the Background Section, specifically in column 4 (lines 15-40). In addition to the above references in Kravitz (US 6,029,150 A), there are several other publications that list anonymous electronic transactions between a customer and merchant, here are a few: Kravitz et al. (US 5,832,089 A), Simon (US 5,768,385 A), and Chaum (US 4,987,593 A). The Applicant fails to acknowledge the Karvitz et al. (US 5,832,089), Simon and Chaum references that were cited in the Office Action mailed on July 6, 2007. The Kravitz'150 reference discusses these other references in detail. It would be obvious for a person having ordinary skill in the art to

review these other references to overcome the deficiencies in (or try to improve) these

systems and discussed by Kravitz.

Double Patenting

2.   The Applicant has filed a Terminal Disclaimer, received on November 5, 2007.

Therefore, the Double Patenting rejection of claims 1 and 9 have been withdrawn.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set ,
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

5.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.
    4.   Considering objective evidence present in the application indicating
          obviousness or nonobviousness.

6.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kravitz (6029150 A), Jones et al. (5623547A) and Schenkler (US 6078902A).

8.   Regarding claims 1 and 9: Kravitz discloses:

        a.   a system for anonymously purchasing goods and services (column 4,

lines 15-40; col. 8, lines 1-15) over the Internet comprising: a communications

system(col. 7,lines 15-55; co1. 12, lines 30-60; Fig. 1 and 2);

        b.   a customer computer linked to said communications system(col. 7,lines

15- 55,co1.12, lines 30-60, Fig. 1 and 2);

        c.   an issuer computer linked to said communications system(col. 7,lines 15-

55,col. 12, lines 30-60, Fig. 1 and 2);

        d.   a merchant computer linked to said communications system(col. 7,lines

15-55,co1.12, lines 30-60, Fig. 1 and 2);

e.   a financial institution computer linked to said communications

system(paragraph 0028);

f.   a money code, said money code containing no identification data related

to a customer and being untraceable to said customer(col. 24, line 15-co1.25,

line 5, fig. 1, 2);

g.   software executing on said customer computer for transmitting an order

and said money code to said merchant computer over said communications

system(Abstract, col. 7,line 1- col. 8, line 65);

h.   software executing on said merchant computer for receiving said order

and money code from said customer computer(Abstract, Col. 8,lines 35-67);

software executing on said issuer computer for receiving said money code and a

money amount from a customer(cols. 1-5), assigning an associated money value

to said money code based on said money amount received from the

customer(cols. 1-5);

i.   transmitting said money code and associated money value to said

financial institution computer over said communications system(cols. 1-5);

j.   software executing on said financial institution computer for receiving said

money code and associated money value transmitted by said issuer computer

and storing said money code and associated money value(cols..1-5);

k.   determining a money amount due for said order, and transferring said

money code and money amount due to said financial institution computer over

said communications system(cols. 1-5);

I. software executing on said financial institution computer .for receiving said

money code and money amount due from said merchant computer(cols. 1-5);

m. comparing said money amount due to said associated money value, and

notifying said merchant computer of fund availability(cols. 1-5).

9. Kravitz does not disclose the exact term "money code". However, Jones et al.

does teach a value transfer system which allows value to be transferred between

electronic purses with a transaction code (money code) assigned to the money amount

that uniquely identifies the transaction (Abstract, col. 2,lines 45-60, col. 3, lines 1-45);

Therefore, it would have been obvious to one of ordinary skill in the art the time the

Applicant's invention was made to modify the teachings of Kravitz to include the step of

Jones et al. The motivation to combine these references is to efficiently transfer money

from point to point.

10. Kravitz and Jones et al. fail to teach transmit money code from Merchant to

customer over network. However, Schenkler does teach money code in place of

electronic wallet and an electronic wallet is used to transmit money over a network.

Therefore, it would have been obvious to one of ordinary skill in the art the time the

Applicant's invention was made to modify the teachings of Kravitz and Jones et al to

include the step of Schenkler. The motivation to combine these references is to facilitate

funds transfer over a network.

11.   Claims 2,3,4,5,6,7,10,11,12,13,14,15 and 17 rejected under 35 U.S.C. 103(a) as

being unpatentable over Kravitz, Jones et al. and Schenkler as applied to claims 1 and

9 above, and further in view of Linehan(6327578B1) and Wong et al.(5913203A).

12.   Regarding claims 2, 10 and 17: Kravitz, Jones et al. does not disclose customer

computer for generating said money code, and inputting said money code and

associated money value into said issuer computer; transmitting said money code and

associated money value from said issuer computer to a financial institution computer

over a communications system; transmitting an order and said money code from a

customer computer to said merchant computer over said communication system;

verifying fund availability by comparing said money amount due to said associated

money value on said financial institution computer. Linehan discloses:

    a. a customer computer for generating said money code (col. 4, lines 15-25, i.e.

    "consumer's computer then sends over the internet network some consumer

    identity and authentication information" and col. 5, lines 50-67, i.e. "step of

    sending from a consumer's computer a start message")

    b. assigning an associated money value to a money code corresponding to a

    money amount surrendered to an issuer by a customer(Table 1 in col. 11, col.

    13, lines 60-67 and col. 14, lines 1-15, claim 1, i.e. "issuing bank creating a

    reference number or value representing the consumer's credit or debit card

    number")

c. inputting said money code and associated money value into said issuer

computer(col. 4, lines 10-20, "initiation message includes payment amount")

d. transmitting said money code and associated money value from said issuer

computer to a financial institution computer over a communications system(col.

6, lines 50-65, i.e. "sending a settlement message")

e. transmitting an order and said money code from a customer computer to said

merchant computer over said communication system(col. 4, lines 10-20, i.e.

"sending from a customer's computer a start message over an internet network

to a merchant's computer")

f. transmitting said money code and a money amount due from said merchant

computer to said financial institution computer over said communications

system(col. 6, lines 50-65, i.e. "sending a settlement message")

g. verifying fund availability by comparing said money amount due to said

associated money value on said financial institution computer(col. 6, lines 10-16,

i.e. "verifies that the consumer's account is active and has sufficient funds").

13. Kravitz, Jones et al.and Linehan does not explicitly disclose(s) that storing said

money code on a storage device or said money code containing no identification data

related to a customer and being untraceable to said customer. However, in col. 6, lines

45-60, col. 7, lines 55-63 thereof, Wong et al. disclose(s) the user selects the level of

anonymity and traceability desired and that once the pseudo cash unit is generated, a

record generation means generates an active record associated with the pseudo cash

unit and the fixed monetary value and stores the active record in records storage

medium, which is preferably some type of electronic data storage device. It would be

obvious to one of ordinary skill in the art to modify the invention of Kravitz, Jones et al.

and Linehan based on the teachings of Wong et al. The motivation to combine these

references is to enable the selection of anonymous, untraceable transaction to conduct

transactions anonymously ensuring the consumer's identity remains confidential, and to

use a storage device to store codes to ensure codes are available when needed.

14.   Regarding claims 3 and 11: Linehan disclose generating a personal identification

code to be associated with said money code for controlling access and use of said

money code (col. 2, lines 45-50, i.e. "password", col. 4, lines 15-25, i.e. "consumer

identity and authentication information" and col. 7, lines 55-67, "the user's identification

and authentication information and the merchant's initiation message" and claim 1, i.e.

"consumer identity and authentication information").

15.   Re claims 7 and 15: Linehan disclose communications system comprises the

Internet (col. 5, lines 55-60).

16.   Re claims 8 and 16: Linehan disclose merchant computer for operating and

maintaining an Internet website, accessible by the customer, for facilitating commercial

transactions between the customer and a merchant(col. 2, lines 40-45, i.e. "Web

server").

17.   Re claims 4 and 12: Linehan does not explicitly disclose(s) that encrypting said

money code. However, in col. 2, lines 35-67 thereof, Wong et al. disclose(s)that the

"Digicash" or "ecash" system turns a user's or buyer's hard drive on a PC into a purse.

To use this system, one first establishes an account with a bank. To obtain digicash or

ecash, the user creates a series of numbers that will represent a mixture of coins or

money bills in various denominations according to the user's own wishes. This request

for digicash is then sent to the bank, which deducts the total amount requested from the

user's existing valid account. The bank then sends the user an equivalent amount of

ecash as an encrypted email message containing a series of numbers. Each number

corresponds to a specified amount of money. Thus, it would have been within the level

of ordinary skill in the art to encrypt a code to ensure anonymity in the transaction.

18.   Re claims 5 and 13: Linehan disclose customer computer for requesting said

personal identification code from the customer, retrieving said money code from said

storage device(col. 4, lines 10-25, i.e. "consumer's computer starts message from digital

wallet" and lines 30-35, col. 7, lines 55-67, i.e. "the merchant sends to the customer

computer, the wallet initiation message" and "then in step 306, the consumer's wallet is

started"), and said money code based on said personal identification code prior to

transmitting said money code to said merchant computer(col. 5, lines 55-60, i.e.

"sending from a consumer's computer a start message over an internet network to a

merchant's computer").

19.   Linehan does not explicitly disclose decrypting an item after it reaches its

destination. However, this is well known in the computer art. Thus, it would have been

obvious to one of ordinary skill in the art to employ decryption to unencrypt a code or

message when it reaches the merchant to get the benefit of encryption in transit to

preservethe anonymity of data in transit.

20.   Re claims 6 and 14: Linehan discloses:

    a.   merchant computer for requesting said personal identification code from the

customer upon receipt of said order and money code(col. 5, lines 55-67, i.e. "the

merchant's computer replies to consumer's computer", and col. 6, lines 45-67,

i.e. "once the merchant has received the authorization token from the issuer")

    b.   customer computer for requesting said personal identification code from the

customer and transmitting said personal identification code to said merchant

computer(claim 1 ,i.e."sending from the consumer's computer consumer identity

and authentication information")

    c.   said merchant computer for receiving said personal identification code from

the customer and transmitting said personal identification code in addition to the

money code and money amount due to said financial institution computer over

said communications system(col. 4, lines 10-25, i.e. "merchant sends a

message, including reference value to acquirer gateway operating on behalf of

an acquirer bank" and col. 6, lines 45-67, i.e. "once the merchant has received

the authorization token from the issuer gateway, the merchant completes the

sales transaction")

d. said financial institution computer for receiving said money code, money

amount due, and personal identification code and decrypting said money code

using said personal identification code prior to determining fund availability(col. 6,

lines 45-67, i.e. "once the merchant has received the authorization token from the

issuer gateway, the merchant completes the sales transaction", and co1.6, lines

5-20, i.e. "verifies customer account is active and has sufficient funds and/or

credit to support the payment amount.").

21.   Linehan does not explicitly disclose that software executing on various

computers. However, Linehan does indicate browser in col. 1, lines 43-46 and since

computers cannot operate without software, it would have been obvious to one of

ordinary skill in the art to employ software applications on a computer to get the benefit

of the four-party communications payment system.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Muriel Tinkler whose telephone number is (571)272-

7976. The examiner can normally be reached on Monday through Friday from 7:30 AM

until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

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MT
November 21, 2007

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PRIMARY EXAMINER